REMARKS

Claims 1, 2, 4-6 and 8 are pending in the instant application. Claims 1, 2, 4-6 and 8 have been rejected. Claim 8 has been amended to correct a typographical error. No new matter has been added by this amendment. Entry of these amendments and the following remarks is respectfully requested.

I. Objection to Claim 8

Claim 8 has been objected to. Specifically the Examiner suggests that the term "hydrophillic" should be --hydrophilic--. Thus, in an earnest effort to advance the prosecution, Applicants have amended claim 8 in accordance with the Examiner's suggestion. No new matter is added by this amendment. Withdrawal of this objection is respectfully requested in light of this amendment.

II. Rejection of Claims 1, 2, 4-6 and 8 under 35 U.S.C. 102(b)

Claims 1, 2, 4-6 and 8 have been rejected under 35 U.S.C. 102(b) as being anticipated by Tsubota et al. (U.S. Patent 5,049,417). The Examiner suggests that the final product of Tsubota et al. is substantially identical to the product of the present invention because free water remaining in the final product of Tsubota et al. is in a trace amount. Further, the Examiner suggests that amendment of the claim to recite that "substantially no water is used

in production of the adhesive" is a process step. However, the Examiner suggests that the present claim is a product and patentability of a product does not depend on its method of production.

Applicants respectfully traverse this rejection.

The Examiner relies upon the holding of In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985) to suggest that "the patentability of a product does not depend on its method of production." In In re Thorpe, however, the difference in the process used to produce the product was addition of two ingredients, namely metal oxide and carboxylic acid separately, as opposed to the prior art process which used a more expensive pre-reacted metal carboxylate. The end product, by either process, however, ended up containing metal carboxylate. The fact that the metal carboxylate was not directly added, but instead was produced in situ, did not change the end product. The fact situation in In re Thorpe is quite different to the instant invention, wherein the process steps impart a distinctive structural characteristic to the final product.

MPEP 2113 is clear; the structure implied by the process steps should be considered when assessing patentability of product by process claims over the prior art, especially where the manufacturing process steps would be expected to impart distinctive structural characteristics

to the final product. Also see In re Garnero, 412 F/2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

Structural characteristics of the product produced by the methodology of Tsubota et al. are distinct from the structural characteristics of the present invention.

In particular, the product of Tsubota et al. has communicating pores formed by water droplets used in its production process which have a diameter preferably larger than the width of the adhesive layer (see col. 4 lines 4-32) which extend from the external surface of the adhesive layer to the internal surface of the adhesive layer (see claim 1). The adhesive of the present invention produced with substantially no water does not contain these communicating pores.

In an earnest effort to advance the prosecution of this case, Applicants are submitting herewith a Declaration by inventor Yasukochi inclusive of data demonstrating that unlike the adhesive tape of U.S. Patent 5,049,417 (Tsubota et al.), the adhesive of the present invention has no communicating pores. Paragraph 6 of inventor Yasukochi's Declaration describes experiments wherein adhesives were prepared in accordance with teachings of Examples 1 and 2 of the present invention and SEM photographs of the surfaces as well as a cross-sectional view were taken. The SEM photographs provided as an attachment to inventor

Yasukochi's Declaration show that the surfaces of the adhesive layers of the present invention are flat and have no communicating pores. Comparison of the SEM photograph showing the cross section of the adhesive of Example 1 of the present invention with the adhesive layer depicted in Figure 1C of U.S. Patent 5,049,417 (Tsubota et al.) (see paragraph 6 of inventor Yasukochi's Declaration) as well as Figure 2 of Tsubota et al. shows this structural difference, specifically the absence of communicating pores in the adhesives of the present invention versus the presence of these communicating pores (4) in the air-permeable adhesive tape of Tsubota et al., quite clearly.

Further, Tsubota et al. require addition of the crosslinking agent to the water applied onto the adhesive layer to prevent the entire adhesive layer from undergoing cross linkage. See col. 6, lines 33-51 of Tsubota et al. Instead, in the product of Tsubota et al., only the portions of the adhesive layer contiguous with the water drops undergo crosslinking. See col. 6, lines 36-40 of Tsubota et al. In contrast, the adhesive product of the present invention comprises a polymer crosslinked by a boron-containing compound. Thus, the entire adhesive layer of the present invention is crosslinked, a structural characteristic which Tsubota et al. actually teach away

from. See col. 6, lines 45-48 wherein Tsubota et al. teach that:

> [i]f the crosslinking agent were contained in the adhesive solution itself, then the entire adhesive layer would be crosslinked, and consequently the adhesiveness of the layer would be poor.

Thus, the process of producing the claimed product with substantially no water results in a structurally distinct product as compared to Tsubota et al. without communicating pores and with crosslinkage throughout the adhesive layer. This structurally distinct product produced with substantially no water is in no way anticipated by the teachings of Tsubota et al.

In addition, claim 8 requires that the boron-containing compound be dissolved in a hydrophilic organic solvent, not water as required by Tsubota et al. Further, there is no teaching of incorporation of a drug into the adhesive tape of Tsubota et al. in accordance with instant claim 6. Thus, this reference also fails to teach all the elements of all the instant claims as required by MPEP 2131 to anticipate the instant claims.

Withdrawal of this rejection under 35 U.S.C. 102(b) is therefore respectfully requested.

III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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